

REMARKS/ARGUMENTS

Claims 1-43 are pending in this application. Claims 33 and 39-43 are allowed. Claims 6 and 18-22 are objected to. Claims 2, 5, 7, 11, 12, 23-25, 28, 31, and 34-38 stand rejected under 35 U.S.C. § 112, first paragraph. Claims 1-5, 7-10, 12-17, and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. US 2001/0028730 A1 ("Nahata") in view of U.S. Patent No. 5,717,776 ("Watanabe"). Claims 27-30 and 32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Watanabe in view of U.S. Patent No. 5,475,460 ("Stephenson"). Applicants respectfully request reconsideration of the present application in light of the above recited amendments and below recited remarks. It is respectfully submitted that the no new matter has been added by the present amendments.

Drawings

The attached replacement sheets 1-20 of formal drawings, comprising figures 1, 2, 3, 4A, 4B, 4C, 4D, 4E, 4F, 4G, 4H, 4I, 4J, 5, 6A, 6B, 7A, 7B, 8, 9, 10A, 10B, 11, 12, 13, 14, 15, 16, 17 and 18, replace the original sheets 1-16 comprising figures 1, 2, 3, 4A, 4B, 4C, 4D, 4E, 4F, 4G, 4H, 4I, 4J, 5, 6A, 6B, 7A, 7B, 8, 9, 10A, 10B, 11, 12, 13, 14, 15, 16, 17 and 18. The attached replacement sheets do not include amended drawings, but rather formal drawings consistent with the original drawings.

This amendment is submitted to comply with the requirement for formal drawings.

Information Disclosure Statement

The Examiner has requested an explanation of the relevance of Documents AD and AI from the IDS dated 11/27/01. Applicants note 37 C.F.R. § 1.98 and MPEP § 609 A (3), which state that an applicant need only provide an explanation of relevance of non-English references. Applicants respectfully decline to provide an explanation of relevance.

Claim Rejections 35 U.S.C. § 112

Claims 2, 5, 7, 11, 12, 23-25, 28, 31, and 34-38 stand rejected under 35 U.S.C. § 112, first paragraph as allegedly being indefinite. The Examiner asserts that the terms “about and apparent” are relative terms which render the claims indefinite.

With respect to claims 23-25, 28, and 34, Applicants respectfully submit that the term “about” has been held to be clear and definite (See MPEP 2173.05(b); *Ex Parte Eastwood* 163 USPQ 316 (Bd. App. 1968).

With respect to claims 2, 5, 7, 11, 12, 23-25, 28, and 34-38, Applicants respectfully submit that the term “apparent” is clearly defined in the Specification (Paragraphs 88-93). Upon reading the Specification, one skilled in the art would clearly understand that an apparent extension may be an extension created by an offset of channel depth of fields relative to the axis on which they are offset. For example, the Specification states, “in Figure 11, each channels depth of field is about 3 inches. By offsetting the first NFOV channel from the second NFOV channel with about a inch overlap, about 5 inches of apparent depth of field can be created.” This concept is clearly illustrated in Figures 11-14.

Accordingly, withdrawal of the rejection of these claims is requested.

Claim Rejections 35 U.S.C. § 103(a)

Claims 1-5, 7-10, 12-17, and 26

Claims 1-5, 7-10, 12-17, and 26 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. US 2001/0028730 A1 (“Nahata”) in view of U.S. Patent No. 5,717,776 (“Watanabe”). Applicants respectfully disagree.

The present application is directed to an iris capture device having expanded capture volume. More specifically, there is disclosed:

The iris image capture device having an expanded capture volume includes two lens systems and two illuminators. The lens systems include a first lens system and a second lens system that are offset from one another in one or more of a X-axis, a Y-axis, and a Z-axis and arranged to capture an iris image of at least one of a left eye and a right eye. The illuminators include a first illuminator positioned outboard of the second lens system and a second illuminator positioned outboard of the first lens system. The first illuminator and the second illuminator are offset from one another in one or more of a X-

axis, a Y-axis, and a Z-axis for illuminating an iris of at least one of a left eye and a right eye. The first lens system operates with the first illuminator and the second lens system operates with the second illuminator to illuminate an iris of an eye and capture an image of the iris (Application, Summary of the Invention)."

Nahata discloses a multiple view angles camera including a narrow view angle lens, a cylinder lens, and an image sensor.

Watanabe discloses a certification card producing apparatus. The apparatus includes a photo mechanism having a prism, a lens, and an illumination lamp. Specifically, Watanabe discloses:

"[d]uring the eyesight test, the light from the illumination lamp is reflected from the disk, passes through the prism, and illuminates the eyeball of the renewer. The reflected light from the eyeball is reflected from the prism, passes through the onefold lens, and focuses on the contact sensor (Watanabe, Col. 6, lines 39-45).

Importantly, the combination of Nahata and Watanabe does not teach or suggest first and second illuminators each positioned outboard of the opposing lens system, as recited by claim 1 of the present application. In the Office Action, the Examiner states, "The limitations [of claim 1] involving illuminators cannot be found in the Nahata reference, however the Watanabe reference clearly shows an illumination means, as Element 97, in Figure 6." Applicants do not dispute that Watanabe discloses an illuminator. However, Applicants respectfully submit that, in Watanabe, both the illuminator and the lens are positioned directly in front of the eyeball of the subject, and, therefore, the illuminator is not outboard of the opposing lens system (See Fig. 6; Col. 6, lines 29-45).

In fact, Watanabe expressly teaches away from positioning the illuminator outboard of the opposing lens system. Specifically, as shown in Fig. 6, the illuminator (97), the lens (93), and the eye chart (95) are all positioned on the same "X" axis directly in front of the eyeball (91). The positioning of these elements directly in front of the eyeball is not accidental. In fact, both the eye chart and the lens are positioned directly in front of the eyeball so that the subject can stare straight ahead at both. Additionally, the illuminator is positioned directly in front of the eyeball so that the illuminator may shine directly on the eye chart (See Watanabe, Fig. 6; Col. 6, lines 29-45).

Applicants respectfully submit that dependent claims 2-5, 7-10, 12-17, and 26 are patentable at least by reason of their dependency.

Claims 27-30 and 32

Claims 27-30 and 32 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Watanabe in view of U.S. Patent No. 5,475,460 ("Stephenson"). Applicants respectfully disagree.

The Examiner cites Stephenson as teaching an angle of separation between a light source and a lens. The Examiner states that, "it would have been obvious to one of ordinary skill in the art to combine the teachings of Watanabe and Stephenson for the purpose of reducing glare, as well as image abnormalities (Office Action, page 7).

Applicants respectfully disagree and submit that there is no motivation to combine the teachings of Watanabe and Stephenson. A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000). The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (quoting *Interconnect Planning Corp. v. Feil*, 774 F. 2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). To establish a *prima facie* case of obviousness, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

Applicants respectfully submit that there is no motivation to combine the teachings of Watanabe and Stephenson because Watanabe expressly teaches away from an angle of separation between the illuminator and the lens. As discussed previously, Watanabe positions the illuminator, the lens, and the eye chart all on the same X axis directly in front of the

eyeball of the subject (See Watanabe, Fig. 6; Col. 6, lines 29-45). The positioning of these elements directly in front of the eyeball is not accidental. In fact, both the eye chart and the lens are positioned directly in front of the eyeball so that the subject can stare straight ahead at both. Additionally, the illuminator is positioned directly in front of the eyeball so that the illuminator may shine directly on the eye chart (See Watanabe, Fig. 6; Col. 6, lines 29-45). Thus, Watanabe clearly teaches away from the system of Stephenson, in which the illuminator is not positioned directly in front of the subject.

Accordingly, reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejections are respectfully requested.

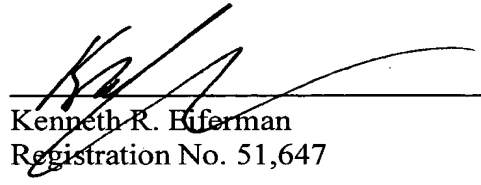
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PATENT

CONCLUSION

In view of the above remarks, Applicant respectfully submits that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested.

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